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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------------|------------------|
| 09/653,595 | 08/31/2000 | Ruth Marie Tritz | 25213 | 4590 |
| 23409 | 7590 | 03/11/2004 | EXAMINER | |
| MICHAEL BEST & FRIEDRICH, LLP 100 E WISCONSIN AVENUE MILWAUKEE, WI 53202 | | | SUBRAMANIAN, NARAYANSWAMY | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3624 | |

DATE MAILED: 03/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/653,595 | TRITZ ET AL. | |
| | Examiner | Art Unit | |
| | Narayanswamy Subramanian | 3624 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 January 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-9, 17-35 and 38-40 is/are pending in the application.
- 4a) Of the above claim(s) 17-25, 33-35 and 38-40 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-9 and 26-32 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

1. This office action is in response to applicant's communication filed on January 26, 2004. Amendments to claims 1, 4, 17, 22-23, 33, 35 and 38 and newly added claims 39, 40 have been entered. Claims 1-9, 17-35 and 38-40 are pending in this application. Election of claims 1-9, 26-32 with traverse by the applicant is acknowledged. Rejection of claims 4 and 5 made under 35 USC § 101 in the last office action is withdrawn in view of the amendments to the claim. Newly added claims 39 and 40 are subject to restriction as discussed below. Elected claims 1-9 and 26-32 have been examined. Claims 17-25, 33-35 and 38-40 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Applicant is respectfully advised to cancel the non-elected claims in response to this office action. The response to amendment, rejections and response to arguments are stated below.

Response to Amendment

2. Arguments with regard to restriction/election requirement have been considered but are non-persuasive. The case for election/restriction in terms of each group of invention requiring separate searches has been clearly presented in the last office action (Paper # 12). Business methods is a relatively new technology center in the Patent Office, considering the duration of other technology centers, and many of the classes and sub classes are broadly defined covering a wide range of concepts and principles. Hence two or more inventive concepts may be classified in the same sub class even though their scope covers vastly different concepts and principles and searches in these sub classes require entirely different searches of vastly different body of literature. Hence classification in the same class and sub class cannot be a test of a serious

burden imposed on the examiner. For these reasons and those discussed in the last office action the restriction/election requirement made in the last office action are maintained.

Also the elected claims 1-9 and 26-32 are drawn to “a computer-implemented method of automatically evaluating a financial account applicant for a financial institution, the method comprising the acts of: accessing credit bureau data for the applicant; accessing account information for the applicant; generating a score for the applicant based on the credit bureau data and the account information; and determining whether to open the financial account based on the score” whereas the newly added claims 39-40 are drawn to “a computer implemented method of evaluating a risk of opening a financial account for an applicant, the method comprising: establishing policy rules and acceptance criteria for financial account applications and storing rules and criteria; acquiring credit-related information for the applicant; acquiring debit-related information for the applicant; generating a first score based on the credit-related information; generating a second score based on the debit-related information; generating a third score based on the credit-related information and the debit-related information; comparing the first, second, and third scores to the policy rules and acceptance criteria; and determining whether to accept or reject the application based on the comparison”. Clearly the scope and utility of the two methods are distinct and independent. They also require separate searches. See 37 CFR 1.111. The applicant elected the former invention by original presentation. Hence the newly added claims 39-40 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Applicant is respectfully advised to cancel the non-elected claims in response to this office action.

Claim Rejections - 35 USC § 101

3. The claim 1 of the invention is directed to non-statutory subject matter. Claim 1 is drawn to a computer-implemented method of automatically evaluating a financial account applicant for a financial institution that is not tied to any technological art. Claim 1 of the invention is directed merely to human making mental computations and manually plotting results on paper, and thus are nothing more than an abstract idea, which is not tied to any technological art, and is not a useful art as contemplated by the constitution. Technology cited in the preamble alone is not given patentable weight. Technology must be present in the body of claims also.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-9 and 26-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (US Patent 6,088,686) as discussed in paragraph 7 of the last office action (Paper No. 12)

Response to Arguments

6. In response to applicant's argument in regards to rejections under 35 USC § 103, that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either

in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine namely that financial institutions would have benefited from marketing their products to their clients based on their credit scores would have been obvious to one with ordinary skill in the art.

In response to applicant's request that Examiner present a reference that discloses generating a score based on the credit bureau data and the account information, the Applicant is respectfully directed to Basch et al (US Patent 6,119,103) (Column 7 line 30 – Column 8 line 2 and Column 9 lines 22-33). Inputs to the FRPS module in Basch include both credit Bureau data as well as account information and the output includes a financial risk score.

The Basch reference has been provided in support of the official notice taken in the last office action and does not constitute new grounds of rejection.

Applicant's other arguments have been fully considered but they are not persuasive. Hence the rejections made in the last office action are maintained.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 3624

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft or Informal faxes to The Patent Office is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

N. Subramanian
February 23, 2004

Richard Weisberger
Primary Examiner

RICHARD WEISBERGER
PRIMARY EXAMINER